

REMARKS

Claims 24-57 are pending in the present application. Claims 24, 39-41, and 49-55 have been amended. Support for the claim amendments may be found throughout the application as filed, for example, on page 9, lines 6-12 and page 23, lines 25-28.

Reexamination of the application and reconsideration of the rejections and objections are respectfully requested in view of the above amendments and the following remarks, which follow the order set forth in the Office Action.

Specification Objection

The Office Action objected to the specification for containing an embedded hyperlink or browser-executable code on page 9, line 28. Applicants respectfully request withdrawal of the objection because the specification has been amended to remove the embedded hyperlink.

Claim Objection

The Office Action objected to claim 27. Applicants respectfully request withdrawal of the objection because claim 27 is amended to delete R⁵.

Rejections under 35 U.S.C. §112

The Office Action rejected claims 52-57 under 35 U.S.C. §112, second paragraph as being indefinite. Applicants respectfully traverse the rejection. Applicants respectfully submit that original claims 52-57 are not indefinite as presented. Nonetheless, in the interest of progressing prosecution, Applicants have amended claim 52 to delete “in a conventional way” and have amended claim 55 to delete “in the conventional way”. As such, claims 52-57 are not indefinite. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Rejections under 35 U.S.C. § 102

The Office Action rejected claims 24, 26, and 38-39 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,319,093 to Huth et al. (“Huth”). Applicants respectfully traverse this rejection.

Amended claim 24 recites an active compound formulation comprising at least one active compound chosen from the group of fungicides, wherein the active compound has a

solubility in water of less than 1000 mg/L at a temperature of 20 °C and at least one random radical copolymer formed from the monomers i), ii) and optionally additional monomers.

Huth discloses polymers and copolymers composed of BCM salts. See, Abstract. BCM is a fungicide that has an advantageously broad spectrum of action. See, c. 2, ll. 43-50. The BCM-AMPS salt disclosed in Huth is water soluble. See, c. 4, ll. 23-27.

Huth does not anticipate amended claim 24 because the reference does not disclose each and every limitation of the claim, which requires that the active compound has a solubility in water of less than 1000 mg/L at a temperature of 20 °C. In contrast, Huth discloses an active compound BCM that is water soluble. As such, Applicants respectfully request withdrawal of the anticipation rejection.

Rejections under 35 U.S.C. § 103

I. Huth

The Office Action rejected claims 24, 26, 29-33 and 38-41 under 35 U.S.C. §103(a) as being unpatentable over Huth. Applicants respectfully traverse this rejection.

Amended claim 24 recites, "...wherein the active compound has a solubility in water of less than 1000 mg/L at a temperature of 20 °C...". In contrast to amended claim 24, Huth does not teach or suggest the active compound has a solubility in water of less than 1000 mg/L at a temperature of 20 °C because the BCM-AMPS salt taught in Huth is water soluble. As such, Huth does not teach or suggest each and every limitation of claims 24, 26, 29-33, and 38-41. For at least these reasons, Applicants respectfully request withdrawal of the rejection of these claims over Huth.

II. Huth and Suarez-Cervieri

Claims 24, 26, 29-33 and 38-41 were rejected under 35 U.S.C. §103(a) as being unpatentable over Huth and further in view of U.S. Patent Publication No. 2005/0032903 to Suarez-Cervieri et al. ("Suarez-Cervieri"). Applicants respectfully traverse this rejection.

Applicants assert that Suarez-Cervieri is not available a reference under 35 U.S.C. §103(a) because it only qualifies as prior art only under 35 U.S.C. §102(e). Under 35 U.S.C. §103(c),

[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of

section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The application corresponding to Suarez-Cervieri was assigned to BASF in 2003 (assignments were executed in 2003 but recorded on June 8, 2004), which is before the filing date of the present application. Thus, at the time the present application was filed on October 19, 2004 (PCT filing date), the application corresponding to Suarez-Cervieri and the present application were co-owned by BASF AKTIENGESELLSCHAFT or were subject to an obligation of assignment to BASF AKTIENGESELLSCHAFT. As such, 35 U.S.C. §103(c) disqualifies Suarez-Cervieri from being available as a reference for rejecting the claims of the present application under 35 U.S.C. §103(a) because Suarez-Cervieri is available as a reference only under 35 U.S.C. §102(e). Applicants respectfully request withdrawal of this rejection.

Applicants would be happy to provide copies of any rejection that has issued in prosecution of the application corresponding to Suarez-Cervieri.

Double Patenting Rejection

The Office Action has provisionally rejected claims 24-41 and 49-57 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-4, 7-11, 13, and 20-21 of copending Application No. 11/918,522 in view of Suarez-Cervieri. Applicants respectfully traverse this rejection. Applicants respectfully request that the rejections be withdrawn in this application, which is the first-filed application. When the present claims are found allowable, the Examiner should assess whether the rejection could then be applied to the later-filed applications.


For the foregoing reasons, claims 24-57 are considered allowable. A Notice to this effect is respectfully requested. If any questions remain, the Examiner is invited to contact the undersigned at the number given below.

The Director is hereby authorized to charge any appropriate fees that may be required by this paper, and to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

BRINKS HOFER GILSON & LIONE

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